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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,689	02/27/2004	Takehiro Okanaka	KASAP047	9344

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EXAMINER

NGUYEN, XUAN LAN T

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,689

Applicant(s)

OKANAKA ET AL.

Examiner

Lan Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/27/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. Figure 13 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
2. It is unclear about the status of figures 9A, 9B, 9C, 10A, 10B, 11A, 11B, 11C, 11D, 12C, 12D, 12E and 12F. It appears from the specification that these figures should be prior art since they are similar to the stopper of figure 13, the stopper of JP9-166175 and the stopper of JP2001-349368. However, Applicant fails to specify that these figures are prior art or not. Furthermore, Applicant does not specify that these figures represent different embodiments of the instant invention. In fact, the specification only mentioned one embodiment of the instant invention in figures 1, 2, 3, 4, 5, 6, 7A, 7B, 8A, 8B, 8C, 9D, 12A and 12B. It is required that an explanation and/or amendments to the specification and the drawings be accompanied to the Response to this Office Action.

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3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed feature “the at least one central projection projects outward from the first abutting plane of the base portion with a height dimension smaller than that of the pair of peripheral projections” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Please note that figures 1, 8B, 8C, 12A, 12C and 12E do not show this claimed feature.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities:
- Page 2, line 27, "229" should be --227--.
 - Table 1 is objected to because of the following reasons:
 - a. There are no explanations for symbols X, O and the triangle.
 - b. Under column "PRESENT INVENTION" and column "COMP. EXAMPLE 4", Thickness [Base] should be 3.5mm, [Peripheral Projection] should be 1.5mm, according to figures 12A and 12C.
 - c. Under column "COMP. EXAMPLE 5", [Central Projection] should be 1.5mm, according to figure 12E.

Appropriate correction is required.

Claim Objections

5. Claims 1, 7 and 8 are objected to because of the following informalities:
- In claim 1, "an superficial surface" should be -- a superficial surface--.
 - In claim 7, "substantial flat abutting surfaces" should be -- a substantial flat abutting surface--.
 - In claim 8, "an connector arm" should be -- a connector arm --.

Applicant is urged to further reviewing the claims for any other defects not cited herein. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 claims "the at least one central projection projects outward from the first abutting plane of the base portion with a height dimension smaller than that of the pair of peripheral projections." However, table 1 and figures 1, 8B, 8C, 12A, 12C and 12E show that the central projections are of the same height as the peripheral projections.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanahashi et al. (EP 0780592 A2) in view of Leibach.

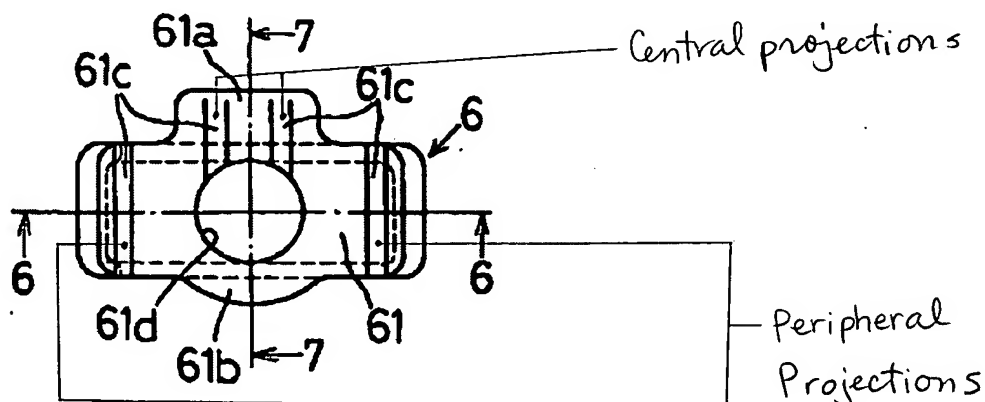
Re: claim 1, Tanahashi et al. show a stopper structure for an engine mount in figure 1 including an elastic body 3 elastically connecting two mounting members 2, 1,

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as in the present invention, the stopper structure comprising: a rigid abutting member 51 connected to one of the two mounting members, and extending in a longitudinal direction with a substantially rectangular shape in cross section as shown in figure 2, and a rubber stopper 6 including: a base portion 61 of tubular shape in cross section, and being secured press-fit onto the rigid abutting member without being adhesive to a superficial surface of the rigid abutting member, as mentioned in the Abstract, a pair of peripheral projections 61c, please see the marked up figure 5 below, formed on laterally opposite sides of a first abutting plane of the base portion and extending in the longitudinal direction of the rigid abutting member, and at least one central projection 61c, please see the marked up figure 5 below, formed on an intermediate area interposed between the pair of peripheral projections of the first abutting plane surface of the base portion, wherein the pair of peripheral projections are situated above laterally opposite corners of a corresponding first abutting plane of the rigid abutting member, respectively, and have a width dimension extending inside and outside the corners of the rigid abutting member, as shown in figure 5. Note that Tanahashi's projections are extending upward while the instant invention's projections are extending downward. However, both projections are in longitudinal directions. Tanahashi lacks the disclosure of the at least one central projection projects outward from the first abutting plane of the base portion with a height dimension smaller than that of the pair of peripheral projections. Leibach teaches the concept of having projection 24 being smaller in height than projection 22 in figure 4 of the engine mount 100 in order to gradually dampen the impact, which in turn would provide a quieter ride. It would have

been obvious to one of ordinary skill in the art at the time the invention was made to have modified Tanahashi's engine mount to have comprised the at least one central projection projects outward from the first abutting plane of the base portion with a height dimension smaller than that of the pair of peripheral projections as taught by Leibach in order to gradually dampen the impact which in turn would provide a quieter ride.

FIG. 5



Re: claim 2, Tanahashi further shows the base portion 61 has a wall thickness dimension larger than the height dimension of the pair of peripheral projections in figure 6.

Re: claim 3, Tanahashi shows the base portion 61 in contact with bracket 4.

Re: claim 4, figure 6 of Tanahashi shows the stopper as claimed.

Re: claims 5 and 7, Tanahashi shows the peripheral projections to be band like, Leibach teaches in column 5, line 44 that the central projections can be conical risers.

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Re: claim 6, figure 5 of Tanahashi shows the arrangement of the central projections and the peripheral projections as claimed.

Re: claim 8, Tanahashi further shows the stopper to be for a hanging type engine mount, a connector arm 2 disposed below the engine mount and that the rubber stopper is brought into abutting contact with an abutting portion, bracket 4, provided on the body of the vehicle.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bucksbee et al., Neeleman, Gross et al., Tomczak et al. and Summers, III et al. show rubber stoppers with gradual dampening capabilities.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Nguyen whose telephone number is 703-308-8347. The examiner can normally be reached on M-F, 8 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 703-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lan Nguyen
Patent Examiner
Art Unit 3683

Lan Nguyen
2/25/05